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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,727	03/04/2002	Shalom Levi	1268-083A	2222

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EXAMINER

TRAN, SUSAN T

ART UNIT

PAPER NUMBER

1615

DATE MAILED: 05/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/086,727

Applicant(s)

LEVI ET AL.

Examiner

Susan Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-13 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-13 and 19-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) \_\_\_\_\_
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152) \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Receipt is acknowledged of applicant's Request for Extension of Time and Amendment filed 03/17/03.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 5-13, and 19-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant's amendment filed 03/17/03 submits new claims 22-28 and introduces the limitation "[carboxylic acid] in free form" into claims 1 and 21, however, applicant has not point out where in the specification provides support for the limitations. Accordingly, it appears that the amendment adds new matters to the specification. Further clarification is requested.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-11, 19-21, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. US 4,909,986.

Kobayashi teaches aqueous deodorant composition comprising water-soluble polymer having molecular weight higher than 15,000, perfumes, citric acid, and other additives (columns 1-2). The water-soluble polymer can be selected from nonionic, anionic, cationic, or amphoteric, including polyacrylic acid or polyacrylamide (columns 5-7, and examples). The aqueous deodorant composition can be applied by spraying onto liquid or solid selected from cattle raising farm, chicken farm, and livestock product, which has malodor and/or gives off malodors (columns 10-12).

The examiner notes the use of the transitional phrase "consisting essentially of" in claim 1. However, since the prior art composition has the same basic and novel characteristic (aqueous deodorant to remove malodors from animal farm), it is an applicant's burden to establish that other additives in the prior art composition are excluded from the claim by "consisting essentially of" language. See, e.g., PPG, 156 F.3d at 1355, 48 USPQ at 1355. Furthermore, even when an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

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It is noted that the reference does not teach that the composition facilitating easy handling of said deodorized excrement recites in claim 21, however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-11, 19-22, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al.

Kobayashi is relied upon for the reason stated above. In the case that the applicant can overcome the above 102 rejection, it is the position of the examiner that it would have been obvious for one of ordinary skill in the art to modify Kobayashi's aqueous deodorant composition with the expectation of at least similar result. The

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reason is Kobayashi teaches the use of the same water-soluble polymer, the same carboxylic acid for the same purpose, *e.g.*, to remove malodors from livestock.

Claims 11-13, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al., and Shimizu US 4,839,089.

Kobayashi is relied upon for the reasons stated above. The reference is silent as to the specific perfume, such as limonene.

Shimizu teaches deodorant composition comprising perfume selected from alpha-pinene, terpenoid, and limonene (column 6, lines 34-36). Thus, it would have been *prima facie* obvious for one of ordinary skill in the art to prepare Kobayashi's deodorant composition using limonene as perfume in view of the teaching of Shimizu, because the references teach the use of perfume to reduce malodors. The expected result would be an aqueous deodorant composition that exhibits a deodorizing effect on liquids and solids, which give off odors.

Claims 1, 5-10, 19-22, 25, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd et al. US 5,882,638.

Dodd teaches aqueous odor-absorbing composition comprising citric acid and water-soluble polymer having molecular weight higher than 15,000, *e.g.*, polyacrylic acid (columns 6-7). Dodd does not teach the use of the composition on animal excrement, and/or composition facilitating easy handling of said deodorized excrement. However, the intended use of the claimed composition does not patentably distinguish the

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composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Accordingly, it would have been *prima facie* obvious for one of ordinary skill in the art to, by routine experimentation prepare Dodd's composition with the expectation of at least similar purpose, because Dodd teaches the use of the same water-soluble polymer and acid to obtain an aqueous deodorant composition.

### ***Response to Arguments***

Applicant's arguments filed 03/17/03 have been fully considered but they are not persuasive.

Claims 1, 2, 5-11, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. US 4,909,986.

Applicant argues that Kobayashi teaches film-forming polymers in such a minute concentration of the high molecular weight copolymer as a flocculant, and therefore, at these concentrations, it is insufficient to form a continuous barrier film. In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e., claimed concentration of film-forming polymer) is not recited in the rejected claims 1 and 21.

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Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant requests further clarification of where in Kobayashi discloses the amount of acid range of 1-10%. Kobayashi in columns 7-8 discloses acids as additives (a) and (b), wherein one or more of the additives are added to the deodorant composition in an amount up to 10000 ppm (1%).

Applicant further alleges that the upper limit of polymer taught by Kobayashi is still lower than the claimed lower limit of 0.1%. However, it is noted that the 0.05 to 50 ppm of water-soluble film-forming polymer disclosed in column 9 is referring to solids weight. Example 54 in column 23 discloses an aqueous solution containing 10% solids of an amphoteric **polymer** of acrylamide/**acrylic acid**.

Applicant argues that the acids taught by Kobayashi are neutralized as their alkali metal or calcium salts, and therefore, does not disclose the claimed invention, "a carboxylic acid in free form". Contrary to the applicant's argument, the salts of acids taught by Kobayashi in column 8 is one of his *prefer* embodiments, many acids uses in Kobayashi are free form (columns 7-8).

Claims 1, 2, 5-11, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al.

Applicant argues that the examiner does not provide reason why a person of ordinary skill in the art would have been motivated to modify Kobayashi to arrive at the



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claimed invention. Contrary to the applicant's argument, applicant's attention is directed to the Office Action dated 11/01/02, in page 5, 2<sup>nd</sup> paragraph, lines 4-6, where the reason for modification of Kobayashi to arrive at the claimed invention is "Kobayashi teaches the advantageous result in the use of the same water-soluble polymer, the same carboxylic acid for the same purpose, e.g., to remove malodors from livestock".

Applicant argues that even if Kobayashi is properly modifiable, the reference still lack the claimed film-forming polymers in sufficient quantities and additionally claimed carboxylic acid be in free form of independent claims 1 and 21. However, as discussed above, the amounts being argued are not recited in the generic claims.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al., and Shimizu US 4,839,089.

In response to applicant's argument that Shimizu is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981). Kobayashi teaches a deodorant composition comprising lemon oil, and perfumes (column 1, lines 30-33); Shimizu also teaches a deodorant composition comprising perfume, such as limonene. In the instant case, Shimizu is relied upon solely for the teaching of limonene which can be incorporated in a deodorant composition.

Claims 1, 5-10, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dodd et al. US 5,882,638.

Applicant argues that Dodd does not teach the use of the composition on animal excrement. However, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963). Accordingly, it would have been *prima facie* obvious for one of ordinary skill in the art to, by routine experimentation prepare Dodd's composition with the expectation of at least similar purpose, because Dodd teaches the use of the same water-soluble polymer and acid to obtain an aqueous deodorant composition.

Applicant further indicated that the examiner agreed that independent claim 1 of the instant application defines over Dodd and other art applied in the parent. The

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examiner is confused? It appears that there was no interview regarding to this instant application, which was held in January 23, 2002 as alleged by the applicant.

### ***Claims Objection***

Claims 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600